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Filing date: **12/10/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	House of Kuipers, LLC		
Entity	Limited Liability Company	Citizenship	California
Address	5304 Derry Avenue, Suite G Agoura Hills, CA 91301 UNITED STATES		
Attorney information	Daniel M. Cislo, Esq. and David B. Sandelands, Esq. Cislo & Thomas LLP 12100 Wilshire Blvd., Suite 1700 Los Angeles, CA 90025 UNITED STATES ttab@cislo.com, David@cislo.com, ksylvester@cislo.com 3109799190		

### Applicant Information

Application No	88228839	Publication date	11/19/2019
Opposition Filing Date	12/10/2019	Opposition Period Ends	12/19/2019
Applicant	John Zox Church St. Sta. - PO Box 3236 New York, NY 100083236 UNITED STATES		


### Goods/Services Affected by Opposition

Class 016. First Use: 2004/09/01 First Use In Commerce: 2004/09/01 All goods and services in the class are opposed, namely: Non-magnetically encoded gift cards; Stickers and transfers
Class 020. First Use: 2005/06/01 First Use In Commerce: 2005/06/01 All goods and services in the class are opposed, namely: Non-metal identification bracelets
Class 022. First Use: 2005/06/01 First Use In Commerce: 2005/06/01 All goods and services in the class are opposed, namely: All-purpose straps comprised of synthetic textile materials; Sacks or bags for the transportation or storage of materials in bulk; String
Class 024. First Use: 2007/01/01 First Use In Commerce: 2007/01/01 All goods and services in the class are opposed, namely: Fabrics for textile use
Class 026. First Use: 2005/06/01 First Use In Commerce: 2005/06/01 All goods and services in the class are opposed, namely: Arm bands; Belt buckles; Charms for shoes; Clothing accessories, namely, charms for attachment to zipper pulls and buttons; Hair bands; Shoe laces
Class 028. First Use: 2007/01/01 First Use In Commerce: 2007/01/01 All goods and services in the class are opposed, namely: Party games

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2992108	Application Date	05/10/2004
Registration Date	09/06/2005	Foreign Priority Date	NONE
Word Mark	ZOX		
Design Mark			
Description of Mark	The mark consists of the word "ZOX" with a representation of feet covered with "slouch" socks forming the bottom half of the "X".		
Goods/Services	Class 025. First use: First Use: 1991/10/29 First Use In Commerce: 1992/10/01 Clothing and accessories; namely, jackets, coats, sweaters, pants, shirts, shorts, swimwear, and undergarments for women and men, jogging suits, T-shirts, tank-tops, jerseys, cotton woven shirts, knit shirts, polo shirts, golf shirts, dresses, blouses, nightgowns, pajamas, sweatpants, sweatshirts, jogging suits, neckties, belts, suspenders, sandals, shoes, caps, hats, wrist bands, head bands, sun visors, scarves, bandannas, ear muffs, gloves, mittens, leg warmers, pantyhose, stockings, leotards, tights, and leggings		

U.S. Registration No.	4412948	Application Date	10/03/2011
Registration Date	10/08/2013	Foreign Priority Date	NONE
Word Mark	ZOX STRAPS		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 014. First use: First Use: 2011/08/00 First Use In Commerce: 2011/09/15 Elastic fabric wristbands in the nature of a bracelet

U.S. Registration No.	4465691	Application Date	05/31/2013
Registration Date	01/14/2014	Foreign Priority Date	NONE

Word Mark	ZOX
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 014. First use: First Use: 2011/08/00 First Use In Commerce: 2011/09/15 Wristbands in the nature of a bracelet Class 025. First use: First Use: 2011/08/00 First Use In Commerce: 2011/09/15 Wristbands; shirts [ ; shoes ]
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U.S. Registration No.	4759961	Application Date	11/02/2014
Registration Date	06/23/2015	Foreign Priority Date	NONE


Word Mark	ZOXBOX
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 025. First use: First Use: 2012/05/30 First Use In Commerce: 2012/05/30 Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Wristbands
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U.S. Registration No.	5233845	Application Date	07/07/2016
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Registration Date	06/27/2017	Foreign Priority Date	NONE
Word Mark	ZOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2011/08/01 First Use In Commerce: 2016/10/31 Backpacks Class 035. First use: First Use: 2011/08/00 First Use In Commerce: 2011/08/00 On-line retail and wholesale store services featuring clothing apparel, wrist-bands, bags and accessories		

U.S. Application No.	88659217	Application Date	10/17/2019
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ZOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1991/10/29 First Use In Commerce: 2011/09/15 Coloring books; Prints		

Attachments	78415788#TMSN.png( bytes ) 85438231#TMSN.png( bytes ) 85948145#TMSN.png( bytes ) 86442364#TMSN.png( bytes ) 87095703#TMSN.png( bytes ) 88659217#TMSN.png( bytes ) Notice of Opposition.pdf(35589 bytes )
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Signature	/Daniel M. Cislo/
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Name	Daniel M. Cislo, Esq.
Date	12/10/2019

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**IN THE MATTER OF TRADEMARK SERIAL NO. 88/228,839**

House of Kuipers LLC, a California limited	)	
liability company, et al.,	)	
	)	
Opposer,	)	
	)	<b>Opposition No.:</b> _____
v.	)	
	)	
John Zox, an Individual,	)	
	)	
Applicant.	)	
	)	

**NOTICE OF OPPOSITION**

Opposer House of Kuipers, LLC, a California Limited Liability Company, having offices at 5304 Derry Avenue, Suite G, Agoura Hills, CA 91301, and its related entity ZOX LLC, a California Limited Liability Company, having offices at 5304 Derry Avenue Suite J, Agoura Hills, CA 91301 (collectively, “House of Kuipers”), believes that it will be damaged by the registration of the trademark shown in Application Serial No. 88/228,839 (the “Application”) filed by ZOX Music and later assigned to John ZOX an individual with address at PO Box 3236 Church Street, New York, New York 100083236 (collectively, “John Zox”). House of Kuipers therefore opposes the Application and requests that registration of the Application be refused.

As grounds for its opposition, House of Kuipers alleges that:

1. John Zox seeks to register a mark that consists of the term ZOX (“Applicant’s Mark”) for use in connection with “Non-magnetically encoded gift cards; Stickers and transfers” (Applicant’s Class 16 Application), “non-metal identification bracelets” (Applicant’s Class 20

Application), “all-purpose straps comprised of synthetic materials; Sacks or bags for the transportation or storage of materials in bulk; String” (Applicant’s Class 22 Application), “fabrics for textile use” (Applicant’s Class 24 Application), and “Arm bands; Belt buckles; Charms for shoes; Clothing accessories, namely, charms for attachment to zipper pulls and buttons; Hair bands; Shoe laces” (Applicant’s Class 26 Application) in International Classes 16, 20, 22, 24, and 26 (collectively, the “Applicant’s Goods”) John ZOX filed the Application on December 13, 2018.

2. This Notice of Opposition is timely filed within the time permitted following publication of the application in the Official Gazette.

3. Applicant’s registration should be denied in connection with Applicant’s Goods because Applicant’s ZOX mark is primarily merely a surname. Furthermore, Applicant has not provided and cannot show substantial, exclusive and continuous use of the mark in commerce in connection with Applicant’s Goods for at least the five years immediately before the date of his application for registration.

4. The Applicant’s Application should be refused in connection with Applicant’s Goods because Applicant’s use of the term “ZOX” does not function as a trademark. Applicant’s specimens show merely ornamental use of the term “ZOX.” A purchaser of the goods would not understand that the term “ZOX” on the Applicant’s Goods is intended to identify the applicant as the source of the goods, but rather would see it only an ornamentation on the goods.

5. The Applicant’s Application should be refused because registration is being sought fraudulently in violation of 15 U.S.C. § 1064(3). As House of Kuipers’ has grown more famous, so have the claims of Applicant that it also now sells the same goods or goods in close proximity to House of Kuipers Goods in interstate commerce. Since as early as 2014, Applicant

has sought to register trademarks that infringe upon and dilute the House of Kuipers' Trademarks (See Serial No. 86954997) on the basis that because Applicant's last name is ZOX and Applicant's late musical band was called "ZOX," it should be entitled to the ZOX trademark across a wide variety of goods. Applicant's musical band, ZOX, has not toured since 2014, and Applicant's specimens do not show goods that have actually been produced, rather provide mockups of goods that Applicant may produce and sell. House of Kuipers has reason to believe that Applicant has not sold any or most of the goods claimed by Applicant in interstate commerce at any point or at least not for five years prior to this Application.

6. Alternatively, Applicant's Application should be refused because registration is being sought for a mark that has been abandoned by Applicant. Any registration would be in violation of 15 U.S.C. § 1064(3).

7. Since at least as early as 1991, House of Kuipers, its predecessors, its assignors, its related companies, or its licensees have continuously used the term ZOX, alone or with another term for a wide variety of retail products and services, including ZOX, ZOXBOS, ZOX STRAPS, and ZOXLIST ("House of Kuipers' Trademarks") in connection with the sale of retail and wholesale products including wristbands, clasp bracelets, hoodies, hoodie strings, dog bags, backpacks, camera bags, small bags, interchangeable bag straps, shirts, wall prints, keychains, lanyards, coloring books, stickers, electronic gift cards and radio frequency identification bracelets, and in close proximity to clothing, accessories and identification bracelets, and paper products ("House of Kuipers' Goods"), the products being sold under the name ZOX and now appearing in connection with House of Kuipers' related trademarks and goods on the zox.la product pages.



8. As background information, since at least as early as 1991, ZOX International, Inc., a Nebraska Corporation, continuously used the term ZOX, Registration No. 2,992,108 in interstate commerce as an identifier of a variety of goods and services, including clothing and accessories; namely, jackets, coats, sweaters, pants, shirts, shorts, swimwear, and undergarments for women and men, jogging suits, T-shirts, tank tops, jerseys, cotton woven shirts, knit shirts, polo shirts, golf shirts, dresses, blouses, nightgowns, pajamas, sweat pants, sweatshirts, jogging suits, neckties, belts, suspenders, sandals, shoes, caps, hats, wristbands, head bands, sun visors, scarves, bandannas, ear muffs, gloves, mittens, leg warmers, pantyhose, stockings, leotards, tights, and leggings in International Class 25. This trademark was registered on the Principal Register on September 6, 2005 from an application filed on May 10, 2004. House of Kuipers was assigned the rights and goodwill associated with Registration No. 2,992,108 on April 25, 2013. The registration was abandoned because House of Kuipers stopped using the design portion of the mark but has continuously used the word portion “ZOX” as a mark in interstate commerce and therefore retains all common law rights in the mark.

9. Since at least as early as 2011, House of Kuipers, its predecessors, its related companies, or its licensees have continuously used the term ZOX STRAPS, Registration No. 4,412,948 in interstate commerce as an identifier of a variety of goods and services, including Elastic fabric wristbands in the nature of a bracelet in International Class 14. This trademark was registered on the Principal Register on October 8, 2013 from an application filed on October 3, 2011.

10. Since at least as early as 2011, House of Kuipers, its predecessors, its related companies, or its licensees have continuously used the term ZOX, Registration No. 4,465,691 in interstate commerce as an identifier of a variety of goods and services, including Wristbands in

the nature of a bracelet in International Class 14 and Wristbands; shirts in International Class 025. This trademark was registered on the Principal Register on January 14, 2014 from an application filed on May 31, 2013.

11. Since at least as early as 2012, House of Kuipers, its predecessors, its related companies, or its licensees have continuously used the term ZOXBBOX, Registration No 4,759,961 in interstate commerce as an identifier of a variety of goods and services, including Wristbands in International Class 025. This trademark was registered on the Principal Register on June 23, 2015 from an application filed on November 2, 2014.

12. Since at least as early as 2011, House of Kuipers, its predecessors, its related companies, or its licensees have continuously used the term ZOX, Registration No 5,233,845 in interstate commerce as an identifier of a variety of goods and services, including Backpacks in International Class 018 and On-line retail and wholesale store services featuring clothing apparel, wristbands, bags and accessories in International Class 035. This trademark was registered on the Principal Register on June 27, 2017 from an application filed on July 7, 2016.

13. Since at least as early as 2011, House of Kuipers LLC DBA ZOX LIMITED LIABILITY, continuously used the term ZOX, Application No. 88/659,217 in interstate commerce as an identifier of a variety of goods and services, including coloring books and prints in International Class 16. This application has a first use date of Oct. 29, 1991 and was filed on Oct. 17, 2019.

14. House of Kuipers' Trademarks have also continuously appeared in substantial advertising and promotion of House of Kuipers' Goods, such that the marks are closely identified with House of Kuipers' Goods and have gained valuable public recognition. House of Kuipers has substantial and continuous sales and advertising in all fifty United States for House

of Kuipers Goods'. House of Kuipers' Trademarks are inherently distinctive or have become distinctive through acquisition of secondary meaning. By virtue of its sales of high-quality products bearing House of Kuipers' Trademarks in interstate commerce, its expenditures of considerable sums for promotional activities, and the excellence of its products, House of Kuipers developed significant goodwill in House of Kuipers' Trademarks and a valuable reputation.

15. House of Kuipers has continuously used House of Kuipers' Trademarks in interstate commerce for retail products and services related to House of Kuipers' Goods, and in close proximity to products, including wristbands, clothing accessories, radio frequency identification bracelets, gift cards, stickers, and interchangeable strings for bags all of which directly overlap with Applicant's Goods since prior to any date upon which John Zox can rely.

16. Applicant's Class 20 Application for "non-metal identification bracelets," directly overlap or are in close proximity to House of Kuipers' Goods, including wristbands, bracelets, backpacks, clothing and accessories (Registration Nos. 2,992,108, 4,412,948, 4,465,691 and 5,233,845).

17. Applicant's Class 22 Application for "fabrics for textile use" directly overlaps with or are in close proximity to House of Kuipers' Goods, including wristbands, bracelets, backpacks, clothing and accessories (Registration Nos. 2,992,108, 4,412,948, 4,465,691 and 5,233,845).

18. Applicant's Class 24 "Arm bands; Belt buckles; Charms for shoes; Clothing accessories, namely, charms for attachment to zipper pulls and buttons; Hair bands; Shoe laces" directly overlap or are in close proximity to House of Kuipers' Goods, including wristbands,

bracelets, backpacks, clothing and accessories (Registration Nos. 2,992,108, 4,412,948, 4,465,691 and 5,233,845).

19. Applicant's Class 26 Application for "all-purpose straps comprised of synthetic materials; Sacks or bags for the transportation or storage of materials in bulk; String" directly overlap or are in close proximity to House of Kuipers' Goods, including wristbands, bracelets, backpacks, clothing and accessories (Registration Nos. 2,992,108, 4,412,948, 4,465,691 and 5,233,845).

20. House of Kuipers' Trademarks are distinctive, strong, and famous such that the public would associate House of Kuipers' Trademarks with House of Kuipers when encountering House of Kuipers' Trademarks apart from House of Kuipers' Goods.

21. Applicant's Mark so resembles House of Kuipers' Trademarks, as to be likely to cause confusion, or cause mistake, or to deceive, in violation of Section 2(d) of The Trademark Act, 15 U.S.C. §1052(d), when used on or in connection with Applicant's Goods.

22. Under the circumstances, registration of Applicant's Mark will injure House of Kuipers by causing the trade or purchasing public to be confused or deceived into believing that John Zox's Goods are those of House of Kuipers or are sponsored by House of Kuipers, and will place a cloud over House of Kuipers' title to its ZOX marks, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

23. House of Kuipers' Trademarks were well established and famous before any priority date upon which John Zox can rely. The registration by John Zox of the ZOX mark in classes that are the same as or in close proximity to House of Kuipers' Goods would diminish and dilute the distinctive quality of House of Kuipers' rights in its famous ZOX marks in violation of 15 U.S.C. §1125(c). Moreover, the registration by John Zox would diminish the

advertising value of House of Kuipers' Trademarks, and such registration would, in the event of any quality problems involving Applicant's Goods, tarnish the distinctiveness of House of Kuipers' Trademarks.

24. Applicant's Mark is likely to lessen the capacity of House of Kuipers' Trademarks to identify and distinguish House of Kuipers' Goods.

25. The Application should be refused because House of Kuipers' rights of continuing its present use of House of Kuipers' Trademarks in commerce are, or would be, threatened by John Zox's registration of the ZOX mark for Applicant's Goods, and because House of Kuipers' business would be otherwise damaged by John Zox's registration of the ZOX mark for John Zox's Goods. The Application is also inconsistent with the prior established rights of House of Kuipers in its House of Kuipers' Trademarks and is now and will continue to be a source of damage and injury to House of Kuipers' Trademarks.

WHEREFORE, House of Kuipers prays that Application Serial No. 88/228,839 be rejected, and that registration for the mark sought for the goods in the Application be denied and refused.

The required fee for opposing one class of goods, and any additional fees, may be charged to House of Kuipers' representative's deposit account No. 03-2030

Respectfully submitted,

CISLO & THOMAS LLP

Dated: December 10, 2019

/Daniel M. Cislo/  
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## **CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Notice of Opposition was served upon John Zox and his attorney of record, by first class mail, postage prepaid, to the addresses listed on the date given below and by electronic mail to [docket@bozpat.com](mailto:docket@bozpat.com).

John Zox  
Church St. Sta. - PO Box 3236  
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Dated: December 10, 2019

/Daniel M. Cislo/  
Daniel M. Cislo, Esq.  
David B. Sandelands, Esq.

## **CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on the date shown below.

Dated: December 10, 2019

/Daniel M. Cislo/  
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